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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,820	11/24/2003	Christoph Nagel	101769-246/tesa AG 1627-W	5356

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EXAMINER	
ROBERTSON, JEFFREY	

ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/720,820	NAGEL ET AL.	
	Examiner	Art Unit	
	Jeffrey B. Robertson	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1203,0804*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being obvious over Gebbeken et al. (US 2003/0134111A1).

3. The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

For claims 1-5, Gebbeken teaches adhesives that contain 25-45 % by weight polymer, 55-75% by weight plasticizer, and 0.3 to 1.2% aluminum chelate crosslinker. Paragraphs [0020]-[0025]. Here, Gebbeken teaches that the polymer is made from 40-90% acrylic acid, 60-10% butyl acrylate corresponding to applicant's (a2) with 0% vinyl monomer. Gebbeken teaches that the polymer is free-radically polymerized in a polar solvent and that there is partial crosslinking of the polymer. Gebbeken teaches that the plasticizer is an ethoxylated alkylamines preferably C16-C18. Although Gebbeken does not teach C20 plasticizers, it would have been obvious to one of ordinary skill in the art at the time of the invention to use C20 ethoxylated alkylamines. These compounds are of sufficiently close structural similarity that there would be a presumed expectation that such compounds possess similar properties. In re Wilder, 563 F.2d 457, 195 USPQ 426 (CCPA 1977).

For claim 5, Gebbeken teaches the presence of the vinyl monomer ethylhexylacrylate in an amount of 30-5%, which includes the 7% requirement of the claim.

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being obvious over Nootbaar (US 2003/0190445A1, corresponds to EP 1,342,684 A, cited as an X reference on the international search report). The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is

thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

For claims 1-5 Nootbaar teaches adhesives that contain 25-45 % by weight polymer, 55-75% by weight plasticizer, and 0.3 to 1.2% aluminum chelate crosslinker. Paragraphs [0041]-[0051]. Here, Nootbaar teaches that the polymer is made from 40-90% acrylic acid, 60-10% butyl acrylate corresponding to applicant's (a2) with 0% vinyl monomer. Nootbaar teaches that the polymer is free-radically polymerized in a polar solvent and that there is partial Nootbaar of the polymer. Nootbaar teaches that the plasticizer is an ethoxylated alkylamines preferably C16-C18. Although Nootbaar does not teach C20 plasticizers, it would have been obvious to one of ordinary skill in the art at the time of the invention to use C20 ethoxylated alkylamines. These compounds are of sufficiently close structural similarity that there would be a presumed expectation that such compounds possess similar properties. In re Wilder, 563 F.2d 457, 195 USPQ 426 (CCPA 1977).

For claim 5, Nootbaar teaches the presence of the vinyl monomer ethylhexylacrylate in an amount of 30-5%, which includes the 7% requirement of the claim.

5. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gleichenhagen et al. (U.S. Patent No. 5,489,642) in view of Franke et al. (U.S. Patent No. 3,706,676).

For claims 1, 4, and 5, Gleichenhagen teaches adhesive materials that contain 100 parts of a copolymer and 80-280 parts by weight of ethoxylated alkylmonoamine plasticizer. Col. 2, lines 36-58. Here, Gleichenhagen teaches that the copolymer is made up of 15-95% by weight of acrylic acid, 0-70% by weight of alkyl acrylates such as butyl-acrylate, and 3-20% of a vinyl monomer. Gleichenhagen teaches the use of an aluminum chelate crosslinker in an amount of 0.01-1.5% by weight. These percentages encompass or include the amounts set forth by applicant. For claim 3, it is the examiner's position that through inclusion of the crosslinker in the composition, partial crosslinking would inherently occur. For claim 2, Gleichenhagen discloses that the polymerization takes place by a free radical mechanism in a polar solvent. Col. 4, lines 4-12.

Although Gleichenhagen teaches the use of ethoxylated alkylmonoamines, the patent fails to teach C20 alkylamines.

Franke teaches water-soluble ethoxylated alkylmonoamines that are derived from eicosane. Col. 3, lines 1-40 and col. 4, lines 57-59. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the ethoxylated water-

soluble monoamines derived from eicosane of Franke in the compositions of Gleichenhagen. The selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in Sinclair & Carroll Co. v. Interchemical Corp., 325 U.S. 327, 65 USPQ 297 (1945).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. D'Haese et al. (U.S. Patent No. 5,125,995), Levine et al. (U.S. Patent No. 5,194,486), Vanhoye et al. (U.S. Patent No. 5,908,908), and Mallya et al. (U.S. Patent No. 6,489,387) are cited for general interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (571) 272-1092. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeffrey B. Robertson
Primary Examiner
Art Unit 1712

JBR